

# Training Module for Chapter 2 of the MPEP

(Revised August 16, 2018)

## Summary

### **Chapter 2: Types, Cross-Noting, and Status of Application**

#### Section 201 – Types of Application

The U.S. Code of Laws includes provisions for three types of patents:

#### **1. Patents for Inventions** (covered in 35 U.S.C. 101)

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions of this title.”

NOTE: *Most of the MPEP relates to Patents for Inventions*

#### **2. Patents for Plants** (covered in 35 U.S.C. 161)

“Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of

this title.”

NOTE: *MPEP Chapter 1600* [Training Module 16]  
*Covers Patents for Plants*

### **3. Patents for Design** (covered in 35 U.S.C. 171)

“Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”

NOTE: *MPEP Chapter 1500* [Training Module 15]  
*Covers Patents for Design*

## **201.01 U.S. Patent Applications (National Applications)**

National patent applications fall into two categories:

● **Normal – (non-provisional) application** shall be made by the inventor or someone authorized by him and contain the following three elements:

- (1) a written specification
- (2) a drawing
- (3) an oath or declaration by the applicant

NOTE: The oath/declaration and fee may be submitted after the specification and drawings are submitted (as permitted). If the fee and oath/declaration are not submitted in the prescribed period, the application will be regarded as abandoned – unless a good case for late submission can be made.

● **Provisional Application** only requires two elements:

- (1) a written specification

(2) a drawing

NOTE: An oath/declaration are not required with the provisional application, but may be included at the option of the applicant.

NOTE: The fee may be submitted after the specification and drawings are submitted (as permitted). If the fee is not submitted in the prescribed period, the provisional application will be regarded as

abandoned – unless a good case for late submission can be made.

- The filing date for both a normal and provisional application shall be the date on which the specification and any required drawing are received in the USPTO.
- An application with a single inventor is termed a “sole” application. An application with more than one inventor is called a “joint” application.
- A provisional application may be viewed as a temporary application does not, in and of itself, afford legal protection to its holder, nor does it receive substantial examination by the USPTO.
- Advantages of a provisional application:

(1) Once filed, it prevents others who conceive of the invention after the filing date from obtaining patent protection. In effect a provisional application locks in a filing date and lock out others.

(2) It is less expensive than a non-provisional application

(3) Its term is 12 months (after the filing date) before it is considered to be abandoned. Thus, the applicant has some time to determine if it would be worthwhile to file a non-provisional application.

(4) A provisional application can be converted into a non-provisional application at any time during the 12 month period after filing.

- Possible disadvantage of a provisional application: It is not entitled to claim priority to an earlier filed application (as is possible with a non-provisional application).
- Usually the term “Patent Application” implies a non-provisional application for purposes of the bar exam.
- The main advantage of a non-provisional patent application is that once allowed to become a patent it provides legal remedies to prevent infringement for a grant period of generally 20 years.

## 201.01 International Patent Applications

While protection against infringement of a granted U.S. Patent is geographically limited to the United States, if broader geographical patent protection is desired, most foreign countries also accept applications for patents. While a U.S. applicant may apply for a patent in any foreign country *after requesting and receiving a foreign filing license from the USPTO*, it is often convenient to file a single International Patent Application that covers all of the approximately 160 countries that participate in the **Patent Cooperation Treaty (PCT)** that is covered in MPEP, Chapter 1800 [Training Module 18].

- To receive a filing date, an international application requires the same filing materials as a U.S. application plus the designation of at least one Contracting State (country). An international patent application designating the U.S. shall have the effect of a National Patent Application filed in the USPTO.
- As might be expected, filing fees associated with an international patent application are somewhat greater than a national patent application.

## Correction of Inventorship in an Application

- Correction of inventorship is liberally allowed by the USPTO. Such corrections require the filing of an amendment.
- Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim.
- If a joint inventor refuses to join in an application for patent or cannot be found, the application may be made by the other inventor(s) on behalf of themselves and the omitted inventor.

The Director may grant a patent to the inventor(s) making the application. However, the omitted inventor may join the application after it is filed.

- Each inventor must include in the oath that he/she files a complete listing of all inventors so as to clearly indicate what he/she believes to be the appropriate inventive entity.
- If multiple conflicting oaths are filed at the USPTO on the same day, all named inventors are considered to be the inventive entity. However, a new corrected oath (or declaration) will be required.
- If filed on different dates, the later filed oath or declaration generally controls.

☐ There are a number of reasons why a change of inventorship is required:

(1) If claims are cancelled, one or more of the originally inventors may no longer have an inventive contribution to the surviving application.

(2) One or more additional inventors may be added if there is an amendment to add additional claims.

- ☐ Inventorship is automatically corrected upon filing the first executed oath or declaration by any inventor on a patent application or filing a cover sheet on a provisional application.
- ☐ A continuing application permits one to claim the benefit of the filing date of a co-pending previously filed patent application provided there is an inventorship overlap between the continuing application and the parent application.

## **Section 211 – Claiming the Benefit of an Earlier Filing Date**

- ☐ A non-provisional application may claim priority to an earlier filed non-provisional, provisional, or foreign application if the following requirements are met:
  - (1) there must be an overlap in inventorship
  - (2) the second application must contain or be amended to contain a specific reference to the first application (or chain of applications) with an indication of the relationship between the applications, and
  - (3) the priority claim must be made within the applicable time limits (generally, the pendency period of the reference application).
- ☐ For applications claiming priority to an earlier filed U.S. application, that application must be “co-pending” with the earlier filed application to be entitled to priority. That is, the second application must be filed before the abandoning or patenting of the first application to claim priority.
  - If there is a chain of prior applications, the co-pendency requirement is satisfied if at least one of the applications in the chain is still pending.

Priority claims to foreign applications are treated like claims in provisional applications. To be eligible for priority, the claim must be made within 12 months of the earlier filed foreign application.

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## Selected Questions and Answers for Chapter 2

### Question 2-1 (oct03am-9a)

Smith's first invention is a new method of fabricating a semiconductor capacitor in a dynamic random access memory (DRAM) cell. Smith filed a first patent application on December 13, 2016 disclosing and claiming the first invention. Smith's later, second invention, is an improved semiconductor capacitor in a DRAM cell and a method of making it. Smith filed a second application on December 16, 2017, claiming the benefit of the filing date of the copending first application. The second application contains claims 1-20, and a specification that provides support for the claimed subject matter in compliance with 35 USC 112, first paragraph. In the second application, claims 1-10 are drawn to Smith's first invention, and claims 11-20 are drawn to Smith's second invention. The primary examiner found a non-patent printed publication authored by Jones published on February 4, 2017. The article discloses the both of Smith's inventions. Which of the following courses of action by the examiner would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner can reject claims 1-20 in the second application using the article because the publication date of the article is earlier than the filing date of the second application.
- (B) The examiner cannot reject any of the claims in the second application using the article because the second application claims the benefit of the filing date of the first application.
- (C) The examiner can reject claims 1-20 in the second application using the article because the second application is not entitled to the benefit of the filing date of the first application since the second application was filed more than one year from the filing date of the first application.
- (D) The examiner can reject claims 1-10, but cannot reject claims 11-20 in the second application because the first application did not disclose the improved capacitor set forth in claims 11-20.
- (E) The examiner cannot reject claims 1-10, but can reject claims 11-20 in the second application because the first application did not disclose an improved capacitor set forth in claims 11-20.

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ANSWER: The most correct answer is (E). See MPEP § 211 that states "A continuation-in-part application may include matter not disclosed in the prior-filed application . See MPEP § 201.08. Only the claims of the continuation –in-part application that are disclosed in the manner provided by 35 U.S.C. 112(a) in the prior filed application are entitled to the benefit of the filing date of the prior-filed application. " However, if a

claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) and *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).” Accordingly, claims 1-10 are entitled to the benefit of the filing date of the first application, but claims 11-20 are not entitled to the benefit of the filing date of the first application because claims 11-20 recite an improved capacitor, which was not disclosed in the first application. Claims 1-10 have an effective filing date earlier than the publication date of the article. Claims 11-20 have a filing date later than the publication date of the article. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application. See MPEP 706.02(a), paragraph “III. 35 U.S.C. 102(a).” Thus, answers (A)-(D) are incorrect.

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## **In-Depth Review of Chapter 2**

Chapter 2 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are **highlighted in yellow**.

### [Chapter 2 MPEP](#)